

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF Application Serial No. 75/341906, filed August 15, 1997

PUBLISHED IN THE OFFICIAL GAZETTE of December 10, 2002, Page TM 5



The United States Playing Card Company,)

Opposer,)

v.)

The British Broadcasting Corporation,)

Applicant.)

12-05-2003

U.S. Patent & TMAO/TM Mail Rpt Dt. #22

Opposition No. _____

OPPOSITION

The United States Playing Card Company believes that it will be damaged by the registration of the mark **BEEB**, Serial No. 75/341906, published in the Official Gazette of December 10, 2002, and hereby opposes registration.

As grounds of opposition, it is alleged that:

1. Opposer, The United States Playing Card Company (hereinafter referred to as "Opposer" or "USPC"), is a corporation organized and existing under the laws of the State of Delaware, located and doing business at 4590 Beech Street, Cincinnati, Ohio 45212.




2. Opposer is a well known manufacturer of playing cards and card games, and is the largest manufacturer of playing cards worldwide.

3. Since long prior to August 15, 1997, the date on which The British Broadcasting Corporation (hereinafter referred to as "Applicant") filed its application to register the trademark **BEEB** for goods including "*ordinary playing cards*" in Class 016 and "*card games*" in Class 028 Opposer has engaged in the business of manufacturing and selling in interstate commerce playing cards bearing the **BEE** trademark.

4. The **BEE** trademark was adopted by Opposer in 1894 as a trademark for playing cards in interstate commerce by using the trademark on the packaging for such products, and

by displaying representations of the mark in advertising and in other ways customary to the trade.

5. Opposer is the owner of the entire right, title and interest in and to the **BEE** trademark for use in connection with playing cards as evidenced by the following U.S. Trademark Registrations issued by the U.S. Patent and Trademark Office on the Principal Register (hereinafter, the "**BEE Marks**"):

Mark	Goods	Reg. No.	Issued
"BEE"	playing cards	49,107	01.23.1906
(design) 	playing cards	60,313	02.05.1907
(design) 	playing cards	555,115	02.19.1952
"BEE" & design 	playing cards	1,771,384	05.18.1993

The above registrations are, in all respects, valid, subsisting and owned by Opposer and are currently in use in interstate commerce. Affidavits of continued use and incontestability under §§ 8 & 15 of the Act of 1946 have been filed and accepted on all four registrations. All registrations have been renewed.

6. On August 15, 1997, Applicant filed an application to register **BEEB** for goods which include "*ordinary playing cards*" in International Class 016 and "*card games*" in International Class 028 under Section 44(d), based on United Kingdom Application No. 2130242, filed on April 21, 1997.

7. Opposer's **BEE** mark and Applicant's **BEEB** trademark are substantially and confusingly similar as applied to "*ordinary playing cards*" and "*card games*." The trademarks are similar in sound, connotation and appearance.

8. Opposer's "*playing cards*" are identical to Applicant's "*ordinary playing cards*" in Class 016 and nearly identical to Applicant's "*card games*" in Class 028.

9. The above-referenced products for which Applicant seeks registration and Opposer's products would ordinarily be sold to the same consumers in the same point-of-sale retail establishments.

10. Opposer has spent and continues to spend large sums of money in the advertisement of goods bearing its **BEE** Marks and by reason of such advertising and the high quality of the **BEE** products, Opposer enjoys a valuable goodwill and an enviable reputation with respect to its trademarks and the goods associated therewith in connection with the **BEE** brand name.

11. As a result of the foregoing, the purchasing public familiar with Opposer's products and Opposer's **BEE** trademark for playing cards is likely to be confused, misled or deceived into thinking that the products Applicant will be selling are in some way sponsored by or connected with Opposer to Opposer's irreparable damage and injury.

12. Opposer will be injured if registration is granted to Applicant because its mark, **BEEB**, when applied to goods in Classes 016 and 028, falsely suggests a connection with Opposer and Opposer's **BEE** brand of playing cards which prominently features the **BEE** Marks. Opposer has no control over the nature and quality of the goods produced by Applicant and thus will be damaged and irreparably harmed by reason of the loss of control over its reputation and the erosion of the goodwill in the **BEE** Marks.

13. Applicant adopted its **BEEB** mark for use on the goods enumerated in Serial No. 75/341906 with prior knowledge of Opposer's **BEE** Marks.

14. As a result of nearly one hundred ten (110) years of continuous and substantial use of its **BEE** Marks, as well as extensive advertising, promotion and sales of products bearing its **BEE** Marks, as well as the considerable goodwill it has developed in its **BEE** Marks, Opposer's **BEE** mark has become a famous trademark within the meaning of Section 43(c) of the Lanham Act.

15. If Applicant is granted registration for its **BEEB** mark in Classes 016 and 028, Opposer will be further damaged and irreparably harmed because registration and use of the **BEEB** mark will dilute the distinctive quality of Opposer's **BEE** Marks.

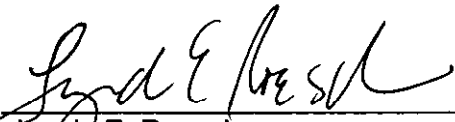
16. For the reasons set forth above, Opposer believes and accordingly asserts that the goodwill in its **BEE** Marks will be damaged and that Applicant should be denied registration of the **BEEB** mark in Classes 016 and 028 for which it has applied.

WHEREFORE, Opposer respectfully prays that the registration sought by Applicant be refused and that this opposition be sustained.

Please recognize as attorneys for this matter Lynda E. Roesch and Michael D. Johns, members of the Bar of the State of Ohio, and J. Michael Hurst, a member of the Bars of the States of Ohio and California, c/o Dinsmore & Shohl, LLP, 1900 Chemed Center, 255 East Fifth Street, Cincinnati, Ohio, 45202. Please address all correspondence to the said J. Michael Hurst, (513) 977-8799.

Please charge the fee of \$600.00, for Opposition to goods in Classes **016** and **028**, as provided by Sections 13 and 31 of the Act of 1946, to our Visa credit card account. Form PTO-2038 is attached. Please charge any additional fees which may be required, or credit any overpayment to our Deposit Account No. 04-1133.

By:



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CERTIFICATE OF MAILING

I certify that the foregoing is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on:

Date of Deposit:

Dec. 2, 2003

Signature:

Judy Beckman

Name:

JUDY BECKMAN

Date of Signature:

Dec 2, 2003

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12-05-2003
U.S. Patent & TMOs/TM Mail Rcpt Dt. #22

December 2, 2003

Box TTAB FEE
Commissioner for Patents & Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: U.S. Playing Card Company's Opposition
to **BEEB**, Serial No. 75/341906

Honorable Sir:

Enclosed is an original and two copies of U.S. Playing Card Company's Opposition to **BEEB**, Serial No. 75/341906. Please charge \$600 to our Visa credit card account. Form PTO-2038 is attached.

Kindly acknowledge receipt of the enclosures by stamping and returning the enclosed postcard. Please charge any additional fees which may be required, or credit any overpayment to our Deposit Account No. 04-1133.

Very truly yours,


J. Michael Hurst

JMH/jlb
Enclosure
cc: Joseph A. Robinette, Esq.
Lynda E. Roesch, Esq.